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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/830,457 | 10/09/2001 | Erez Braun | 109362 | 8069 |

7590 07/01/2004
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EXAMINER

LAM, ANN Y

ART UNIT PAPER NUMBER

1641

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 09/830,457 | Applicant(s) BRAUN ET AL. | |
| | Examiner Ann Y. Lam | Art Unit 1641 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 11 February 2004.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 42-49 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 42-49 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 - 1. Certified copies of the priority documents have been received.
 - 2. Certified copies of the priority documents have been received in Application No. _____.
 - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/11/04.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed February 11, 2004 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. (Examiner does not have a copy of some of the documents listed.)

Claim Objections

Claims 42 (and therefore dependent claims 43-49) are objected to because of the following informalities: in claim 1, line 16, "deposition" should be --deposited. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 42-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 42, line 6, recites the limitation "additionally comprising..." It is not clear as to what (the nucleation center or the recognition group) additionally comprises the recited elements.

Claim 42, line 18, recites the limitation "under appropriate conditions". It is not clear as to what conditions Applicants are referring, nor as to what conditions would be appropriate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Noppe et al., 5,491,098.

Noppe disclose a method for depositing gold at one or more sites on a substrate (column 3, lines 34-35, and column 4, line 43 and 47), comprising:

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(a) providing nucleation centers (i.e., gold marker, column 4, line 43 and 47) at said one or more sites, wherein said nucleation centers are each coupled to a first member (i.e., binding counterpart, column 3, line 49-50) of a recognition group additionally comprising at least a second member (specific binding agent, column 3, line 47) capable of binding to the first member of the recognition group, wherein the second member of the recognition group includes or forms said one or more sites, and is bound to the first member of the recognition group said nucleation centers being selected from the group consisting of a metal particle, a cluster containing metal atoms, a metal-containing complex and molecules containing metal atoms (i.e., developer containing metal ions, specifically gold ions, column 3, line 51; column 5, line 3; and column 16, lines 22-23)

(b) providing a treatment composition (i.e., developer containing gold ions, column 3, line 51; column 5, line 3; and column 16, lines 22-23) which comprises a soluble gold-providing agent and is kinetically stable so that gold is not deposited unless a nucleation center is present; and

(c) contacting under appropriate conditions said one or more sites with the treatment composition whereby gold atoms are released from said gold-providing agent and deposited onto said nucleation center to form gold metal deposits at said one or more sites (column 3, lines 50-51.)

As to claim 43, the first member of the recognition groups is coupled to at least one nucleation center, the nucleation center being one or more of the group consisting

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of: cluster containing metal atoms and metal containing complexes and metals (column 3, lines 46-50; column 5, line 33.)

As to claim 44, the one member of the recognition group is coupled to at least one nucleation center, wherein the nucleation center is one or more of the group consisting of gold particle, cluster containing gold atoms and gold-containing complexes and molecules (column 3, line 49-50; column 4, line 43 and 47.)

As to claim 45, the one member of the recognition group is coupled to at least one nucleation center, the nucleation center being one or more of the group consisting of cluster containing gold atoms and gold-containing complexes and molecules (column 3, line 49-50; column 4, line 43 and 47.)

As to claim 46, said recognition group is a member of the group consisting of: a receptor and a ligand (column 5, line 33.)

As to claim 47, said treatment composition is an aqueous solution (column 3, line 38; column 4, line 13.)

As to claim 49, said reagent is hydroquinone (column 5, line 8.)

Allowable Subject Matter

Claim 48 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to the above rejected claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi (filed March 10, 2000) discloses a method for spectral sensitizing useful as a marker for diagnosis (column 1, line 9; column 52, lines 1-5.) Ooms, 5,266,442, discloses a method of improving silver image including the step of chemically sensitizing silver halide with gold sensitizer (column 2, lines 52-57; column 3, lines 49-53.) Bond discloses a method of photographic image enhancement comprising gold toning of silver image (column 3, lines 19-22, and lines 32-35.)


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is 571-272-0822. The examiner can normally be reached on M-Sat 11-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.L.



CHRISTOPHER L. CHIN
PRIMARY EXAMINER
GROUP 1800-1641

6/14/04